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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,870	04/12/2004	Ki Sung Jin	123056-05004416	1858
43569	7590	09/26/2006	EXAMINER	
MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006			ABEL JALIL, NEVEEN	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,870

Applicant(s)

JIN ET AL.

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/12/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claims 1-7, and 9 are objected to because of the following informalities:

Claims 1-4, recite “*for* copying”, “*for* maintaining”, “*for* storing” etc. which is intended use and does not cause any functionality to occur in the computer since it lacks combination with hardware to realize the functionality. The limitations following the phrase “*for*” describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase “*for*” do not carry patentable weight, which cause the claims to appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form such as “to”, “that”, or just “copying” etc.

Claims 1, 2, and 4, recite an “if” statement, which suggest optionally, passive recitation. If the Applicant intended to have the remaining limitations after the “if” statement to be considered fully and given complete patentable weight. The “if” recitation should be changed to recite more firm and definite language (i.e. wherein). Since “if” statement is optional, the remaining limitation does not necessarily have to happen (i.e. the presentation of document).

Appropriate correction is required.

Claims 4, and 9, both recite the intended use of “in order to copy”, “in order to transmit”, “in order to reflect”, and “in order to optimize”, all of which constitute intended use and does not

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carry patentable weight since it never has to occur. Claims should be amended to recite more firm and positive language (i.e. “to”, “is”, “that”, or “reflecting”). Appropriate correction is required.

Claim 4, line 15, recite “as maintaining” which is vague and should be changed to “by maintaining” to accurately depict the invention. Appropriate correction is required.

Claim 5, line 2, recite “original server uses” which constitute intended use not having to take place. Claim language should be changed to state, “original server provides/employs/or presents” instead. Appropriate correction is required.

Claim 6, line 3, recite, “by using” which constitute intended use not having to take place. Claim language should be changed to state, “based on” instead. Appropriate correction is required.

Claim 7, line 2, recite “is and XML” which is believed to be a typo instead meant to be “is an XML”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, and 4 provides for the use of “copying an XML document to a remote server”, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

There’s no nexus between the preamble and the body of the claim in order to achieve the intended use of “copying an XML document”. Correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, and 4 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims should be amended to recite more direct language by removing the “for” and adding “to” or “that” or “of”, or providing for achieving the use of “for copying” in the body of the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Hsing et al. (U.S. Patent No. 6,826,726 B2).

As to claim 1, Hsing et al. discloses an extensible markup language (XML) database duplicating apparatus for copying an XML document to a remote server without loss of structure and attribute information of the XML document, the apparatus comprising:

an original server for processing and transmitting only changed information of persistent classes of the XML document subject to duplication if a change of XML documents happens in an original database by a client application program (See column 3, lines 1-20); and

at least one copied server for maintaining synchronization by applying the changed information transmitted from the original server to persistent classes of a copied database (See column 4, lines 1-14).

Allowable Subject Matter

8. Although no rejections in view of prior art are made with regards to claims 2-10, no claims in this application will be indicated as allowable until after a response to this action has been reviewed, as to the fact that certain changes may not produce allowable claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McFadden (U.S. Patent No. 6,671,695 B2) teaches dynamic group data structure.

Vaschillo et al. (U.S. Pub. No. 2005/0050068 A1) teaches mapping arbitrary XML architecture.

Mireku (U.S. Pub. No. 2005/0108627 A1) teaches preservations of object in XML environment.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Neevee Jalil', with a stylized flourish at the end.

Neveen Abel-Jalil
September 15, 2006